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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,502	04/15/2004	Shozo Kobayashi	2026-0104006Reg	6567

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EXAMINER

PATTERSON, MARC A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/824,502

Applicant(s)

KOBAYASHI ET AL.

Examiner

Marc A. Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-8 and 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5-8 and 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/28/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Claims 13 and 15 are objected to because of the following informalities: The claims are identical to Claims 12 and 14. Claim 14 also includes the term 'thereinforced,' an apparent typographical error. Appropriate correction is required.

NEW REJECTIONS

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 5 – 8, 10 – 12, 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Bottcher et al (U.S. Patent No. 4,390,745).

With regard to Claims 5 – 7, Bottcher et al disclose a sleeve that is tube shaped (tube, therefore a cylinder; column 9, lines 39 – 43) that is cold – shrinkable (elastic stresses urge the tube to recover into conformity with a substrate; the tube is therefore elastically recoverable; column 5, lines 63 – 68) comprising a polymer that is elastic (elastomer; column 5, line 57), comprising an internal semiconductive layer (layer '9,' which is semiconductive, and which is an internal layer as shown in Figure 2; column 10, lines 17 – 20) and which includes a semiconductive material (carbon black; column 3, lines 40 – 43) and an insulation layer that is

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formed around the internal semiconductive layer (insulating layer; column 5, lines 43 – 46) and is molded (column 11, lines 27 – 33) and which is reinforced (comprising additives to achieve good discharge resistance; column 5, lines 43 – 46); the sleeve has two stress – relief cones, wherein one stress relief cone is formed at each end of the sleeve (each cable shield end; column 6, lines 49 – 56); Bottcher et al also disclose additional layers outside of the layers of the sleeve (column 3, lines 13 – 27); Bottcher et al therefore disclose the addition of two sleeves to the outside of the sleeve, each of which is identical to the sleeve; Bottcher et al therefore discloses an external semiconductive layer, the semiconductive layer of the outermost sleeve, that includes an elastic material and a semiconductive material, and is formed around the reinforced insulation layer, and is insulated from both the stress – relief cones by the other insulation layer of the other additional sleeve; because Bottcher et al disclose an external semiconductive layer that is molded, Bottcher et al disclose an external semiconductive layer that is molded around the reinforced insulation layer; however, the claimed aspect of the semiconductive layer being molded around the reinforced layer is given little patentable weight; Bottcher also discloses edge – cut sections near each of the stress – relief cones (sections ‘x’ and ‘y’ in Figure 2, in which the semiconducting layers are cut off from each other); the claimed aspect of the sections being formed by cutting, however, is directed to a process limitation and is therefore given little patentable weight.

With regard to Claim 8, Bottcher et al do not disclose non – uniformities in thickness; Bottcher et al therefore disclose an external semiconductive layer having a substantially uniform thickness.

With regard to Claim 10 – 11, 14 and 16, as stated above, Bottcher et al disclose additional layers inside of the layers of the sleeve (column 3, lines 28 – 35) and therefore disclose a sleeve that is supported on a disassemble carrier in an expanded state and edge – cut sections that are free of the external semiconductive layer to expose a part of the reinforced insulation layer at each end of the reinforced insulation layer and a reinforced insulation layer that is uncovered by the external semiconductive layer to be exposed.

With regard to Claim 12, the Bottcher et al disclose elastic material comprising ethylene – propylene rubber (column 4, lines 1 – 2).

ANSWERS TO APPLICANT'S ARGUMENTS

4. Applicant's arguments regarding the 35 U.S.C. 102(b) rejection of Claims 5 – 8 as being anticipated by Bottcher et al (U.S. Patent No. 4,390,745), of record in the previous Action, have been carefully considered but have not been found to be persuasive for the reasons set forth below.

Applicant argues, on page 6 of the remarks dated September 15, 2006 that Bottcher et al do not disclose an external semiconductive layer that is molded around the reinforced insulation layer.

However, as stated above, a semiconductive layer that is molded is disclosed by Bottcher et al; an external semiconductive layer, that is molded around the reinforced insulation layer, is therefore disclosed by Bottcher et al. However, the claimed aspect of the semiconductive layer being molded around the reinforced layer is given little patentable weight.

Applicant also argues, on page 8, that an edge cut section at each end of the claimed invention makes molding conditions less critical.

However, as stated above, an edge cut section at each end is disclosed by Bottcher et al.

Applicant also argues, on page 9, that Bottcher et al do not disclose a substantially uniform thickness because Bottcher et al do not disclose non – uniformities in thickness, and request support in the MPEP.

However, because Bottcher et al do not disclose non – uniformities in thickness, it is clear that Bottcher et al anticipate a layer having no non – uniformities, or only few non – uniformities, in thickness, therefore having substantially uniform thickness; furthermore, Bottcher et al disclose a thickness of 2 mm for the semiconductive layer (column 11, lines 31 – 33).

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc A Patterson whose telephone number is 571-272-1497.

The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Marc Patterson 11/27/06
Marc A. Patterson, PhD.
Primary Examiner
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